

R E M A R K S

- Claims 1, 6-23, 25-29, 34-36, 38-39, 41,43-54, 56-57, 59-61, 63, 69-80, and 85-113 are pending in the present application.
- Claims 37, 40, 55, 58, 62, 64-68, and 81-84 have been cancelled
- Claims 1, 29, 38-39, 43, 54, 56-57, 59-61, 63, 69-80, 85-96, and 99-113 are independent.

Claims 37, 40, 55, 58, 62, 64-68, and 81-84 have been canceled and Claims 101-113 have been added. No amendment was made for a reason related to patentability.

I . RCE

This Amendment and Response is being filed in response to a Final Office Action. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of this Amendment and Response.

II. Telephone Interview

We would like to thank the Examiner for the helpful telephone conversation held on February 1, 2005 with our representatives.

The Examiner and our representatives discussed the present application in light of Von Kohorn. Our representatives requested clarification as to the Examiner's position that Von Kohorn teaches or suggests a feature generally directed to *receiving from a customer, an indication of a willingness to purchase at least one but not all of a plurality of products*, as generally recited in the independent claims.

While no formal agreement was reached, we are grateful for the opportunity to discuss the present application with the Examiner.

III. SECTION 112 REJECTION OF CLAIMS 98-100

The Examiner asseverates that claims 98-100 ‘do not make logical sense.’ [Current Office Action, page 2]. However, Applicants believe the Examiner has misread the language of the claims to arrive at a nonsensical interpretation.

The Examiner has read the limitations *arranging for a benefit to be provided based on the purchase of the selected product and wherein the benefit is provided in exchange for the selecting* as mutually exclusive limitations that would require one or the other limitation to occur. However, the recited subject matter is not mutually exclusive. The limitations identified by the Examiner can both be true simultaneously and as such do not require the addition of the exclusive “or” to create alternative limitations.

Applicants’ intent was that the “wherein” clause define the “benefit” of the “arranging” clause – i.e., the *benefit of the arranging step is provided in exchange for the selecting*. Read as such, Applicants aver that a logical interpretation results.

As such, Applicants respectfully request reconsideration and withdrawal of the Section 112 rejection with respect to Claims 98-100.

IV. SECTION 103(a) REJECTION

A. Independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100

Independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,112,186 issued to Bergh et al. (“Bergh”), in view of U.S. Patent No. 5,970,469 issued to Scroggie et al. (“Scroggie”), and further view of U.S. Patent No. 5,227,874 issued to Von Kohorn (“Von Kohorn”). We respectfully traverse the Examiner’s Section 103(a) rejection.

We respectfully submit that Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100 are not obvious in light of Bergh, Scroggie, or Von Kohorn, either alone or in combination. First, no combination of Bergh, Scroggie, or Von Kohorn teaches or suggests all of the features of Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to

combine the cited references to provide for all of the claimed features of independent Claim 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100.

**1. The References Do Not Disclose All the Limitations of
Independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and
99-100**

Independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-113 have been amended to generally recite the limitations:

- *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products*
- *receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*
- *selecting, for the customer by the third party via a computing device one of the plurality of products*

As best understood by us, the Examiner asserts the following to be true with respect to independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100:

Von Kohorn discloses:

- *selecting, for a customer, one of the products from a first product and a second product where the customer has indicated*
 - *the first product and the second product, and*
 - *a willingness to purchase any one of the first product and the second product* [Current Office Action, pages 4-5]
- *the benefit is provided in exchange for the selecting* [Current Office Action, page 6]

We respectfully traverse these assertions. We have carefully reviewed the Von Kohorn and references cited by the Examiner, without finding a teaching or suggestion of *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products*, much less *receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*.

By example, various embodiments of the present invention are directed to:

For example, a customer designating a sixteen ounce jar of pasta sauce as a product category is indicating that the customer does not have a preference, or is at least willing to be flexible, regarding which brand (*i.e.*, Ragu™, Prego™, Heinz™, etc.) of sixteen ounce jar of pasta sauce the customer will purchase.

Thus, the customer is brand-indifferent with regard to a sixteen ounce jar of pasta sauce and is indicating a willingness to trade flexibility for a lower price or other benefit. As another example, the customer may indicate that the customer is willing to purchase any twenty ounce bag of potato chips, whether it be produced by Ruffles, Wise, Lays, Snyder's, etc. Thus, the customer is indicating a brand flexibility with regard to potato chips and a willingness to exchange brand flexibility for a lower price or other benefit.

[Specification page 14, lined 19-29].

The indication or communication received during the step 102 may include, constitute, be part of, or sent along with an agreement, offer, binder, obligation, commitment, etc. from the customer to purchase, rent, lease, etc. at least one product in the indicated product category or categories and/or to purchase, obtain, etc. at least one service in the indicated service category or categories. Thus, the indication provided by the customer may bind or obligate the customer to purchase a product or service if a product or service is found or selected during the step 104 that meets or satisfies the product or service category designated by the customer in the indication received during the step 102.

[Specification page 15, lines 4-14].

In contrast, and contrary to the Examiner's assertion, Von Kohorn is devoid of any hint or suggestion of *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products*, as generally recited in independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100. As the Examiner reminded Applicants' representatives in the interview conducted February 1, 2003, Von Kohorn describes:

The respondent employs the keyboard to enter into a memory of the response unit the identifying numbers of those items for which there is an interest in a **future purchase at a sale or discounted price**.

[Column 99, lines 49-52](Emphasis added). A reading of the plain language of the reference provides support for the Examiner's assertion in the above referenced interview that Von Kohorn describes a system in which one enters items of interest into the Von Kohorn system and waits to see:

- 1) **if the item is available in the future at a sale or discounted price** and

- 2) one will purchase the item in the future only if the future sale or discounted price is enough to induce their interest in making the purchase.

There is nothing in Von Kohorn, however, that would suggest *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products* as the Von Kohorn system may select a plurality of items entered into the system from the plurality of items entered into the system (i.e, selecting Items A, C and D from a list of items A, B, C, D, E, F...etc.).

Further, the Von Kohorn system fails to teach or suggest *receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*. The system of Von Kohorn outputs coupons for items entered into the response unit if they happen to be available at a sale or discounted price in the future. However, the respondent is not bound to purchase the items entered into the response unit.

Accordingly, there is nothing in Von Kohorn that would suggest *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products*, much less *receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*.

As well, we traverse the Examiner's assertion that Von Kohorn teaches or suggests *the benefit is provided in exchange for the selecting*. The Examiner states the above is taught in the reference at Column 47, line 42- Column 48, line 10; Column 2, lines 60 – Column 3, line 5 and Column 2, lines 49-53. [Current Office Action, page 6]. The cited sections of the reference teach being provided credits in exchange for providing acceptable answers to questions and respondent selecting an item for purchase in response to an advertisement. Von Kohorn does not teach or suggest that *the benefit is provided in exchange for the selecting*.

We respectfully submit that the Von Kohorn reference, alone or in combination with any of the references of record, does not disclose all of the limitations of independent Claims **1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100**. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim **1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100**.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100 is incorrect, we request clarification of the Examiner's positions so that the present application may proceed to allowance or appeal.

2. No Motivation to Combine the Cited References

As best understood by us, the Examiner also asserts the following to be true with respect to independent Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100:

As best understood by us, the Examiner has attempted to create a chain of logic to assert that the references of record teach or suggest the limitations of Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100:

- It would have been obvious to one of ordinary skill in the art to modify Bergh in light of Von Kohorn to provide for a feature of *selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated 1) the first product and the second product, and 2) a willingness to purchase any one of the first product and the second product* [Current Office Action, page 4]
- The motivations for this modification above would be to allow flexible incentives for purchasing to be presented to users based on user interests [Current Office Action, page 5].

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (b) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (b) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

a. The Asserted Motivation is Not Shown in the Cited References

We have carefully reviewed the Office Action issued in the present application, as well as the Bergh and Von Kohorn references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise.

b. The Asserted Motivation Does Not Suggest the Desirability of *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products and receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*

Further, the motivation of stated above, as asserted by the Examiner, would not suggest the desirability of modifying the recommendation system of Bergh to provide specifically for the feature of *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products and receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products*, as recited in independent Claim 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100. The Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of allowing flexible incentives for purchasing to be presented to users based on user interests, would specifically suggest to one of ordinary skill in the art the desirability of provide for *receiving, from a customer, an indication of a willingness to purchase one of a plurality of products and receiving, from the customer, a binding agreement to purchase the one product selected by a third party from the plurality of products* in the Bergh system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivation in Von Kohorn reference amounts to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the

Examiner. We respectfully submit that the purported motivations do not suggest any such modification of the Bergh system.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claim 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the list of items (a) - (d) above so that the present application may proceed to allowance or appeal.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims 1, 29, 38-39, 41, 56-57, 61, 63, 69-84, and 99-100.

B. Dependent Claims 6-15, 17-21, 25-28, 34-36, 44-47, 49-53 and 97

Dependent claims 6-15, 17-21, 25-28, 34-36, 44-47, 49-53 and 97 are dependent upon the respective independent Claims discussed above in Section A. As claims 6-15, 17-21, 25-28, 34-36, 44-47, 49-53 and 97 incorporate the limitations of the respective independent claims above by reference, claims 6-15, 17-21, 25-28, 34-36, 44-47, 49-53 and 97 are allowable at least for the same reasons discussed above.

C. Independent Claims 43, 54, 59, 60, and 85-96

Independent Claims 43, 54, 59, 60, and 85-96 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,112,186 issued to Bergh et al. (“Bergh”), in view of U.S. Patent No. 5,970,469 issued to Scroggie et al. (“Scroggie”), and further view of U.S. Patent No. 5,227,874 issued to Von Kohorn (“Von Kohorn”). We respectfully traverse the Examiner’s Section 103(a) rejection.

We respectfully submit that Claims 43, 54, 59, 60, and 85-96 are not obvious in light of Bergh, Scroggie, or Von Kohorn, either alone or in combination. First, no

combination of Bergh, Scroggie, or Von Kohorn teaches or suggests all of the features of Claims **43, 54, 59, 60, and 85-96**.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of Claims 43, 54, 59, 60, and 85-96.

1. The References Do Not Disclose All the Limitations of Claims 43, 54, 59, 60, and 85-96

Independent Claims **43, 54, 59, 60, and 85-96** have been amended to generally recite the limitations:

- *receive, from a customer, an indication of a product or service the customer is willing to purchase from any one of a first retailer or a second retailer*
- *selecting, for the customer via a computing device, one of the first retailer and the second retailer and providing an indication of a benefit if the product or service has been purchased at the selected retailer where the benefit being provided in exchange for the selecting*

By example, various embodiments of the present invention are directed to:

The method 900 can be used with the systems 200 and 250 and for allowing a customer to indicate retailer flexibility by selecting, identifying or modifying a retailer category or by indicating two or more acceptable retailers at which a customer is willing to purchase one or more products or services. The method 900 includes the step 110 previously described above. In addition, the method 900 includes a step 902 during which an indication, designation, selection, etc. is received by customer device, the controller 202, a retailer device, etc. regarding an acceptable retailer category or retailer of interest. In such an indication, a customer, customer device, etc. may indicate the store at which the customer would like to purchase or otherwise obtain at least one product or service. The customer may designate a single retailer, a retailer category, a collection of stores, a mall, a chain or stores, etc.

[Specification, page 44, lines 19-30].

A retailer category may include a plurality of retailers, such as stores in a particular franchise or chain, drug stores, department stores, stores in a particular mall or shopping center, stores providing certain types of products (e.g., toys, clothing, grocery items, hardware, etc.), stores in a particular geographic area,

stores open during a specific time of day, stores willing to take credit cards, stores willing to accept coupons, stores owned or managed by particular people, etc. By designating a retailer category in the indication or message received during the step 902, a customer is indicating, or even promising, to purchase at least one product or service at any one of the retailers in the indicated retailer category.

[Specification, page 44, line 31 to page 45, line 9].

As best understood by us, the Examiner asserts the following to be true with respect to claims **43, 54, 59, 60, and 85-96**:

Bergh discloses:

- *a retail category where the retailer category is restaurants, clothing stores, World Wide Web pages, etc.* [Current Office Action, page 4]

Von Kohorn discloses:

- *the product can be a service or organization*
- *an organization can be a retailer* [Current Office Action, page 5]

We respectfully traverse these assertions. We have carefully reviewed the Bergh and Von Kohorn references cited by the Examiner, without finding a teaching or suggestion of *receiving, from a customer, an indication of a product or service the customer is willingness to purchase the product or service from any one of a first retailer or a second retailer or selecting, for the customer via a computing device, one of the first retailer and the second retailer and providing an indication of a benefit if the product or service has been purchased at the selected retailer where the benefit being provided in exchange for the selecting*. Specifically, the cited portions of Bergh teach:

The amount of information, as well as the number of goods and services, available to individuals is increasing exponentially. This increase in items and information is occurring across all domains, e.g. sound recordings, restaurants, movies, World Wide Web pages, clothing stores, etc. An individual attempting to find useful information, or to decide between competing goods and services, is often faced with a bewildering selection of sources and choices.

[Column 1, lines 24-32].

As referred to in this description, items to be recommended can be items of any type that a user may sample in a domain. When reference is made to a "domain," it is intended to refer to any category or subcategory of ratable items, such as

sound recordings, movies, restaurants, vacation destinations, novels, or World Wide Web pages. Referring now to FIG. 1, a method for recommending items begins by storing user and item information in profiles.

[Column 3, lines 17-25].

The cited portions of Von Kohorn teach:

Advertisement 1001 also may promote a service, an organization, a resort, or any offering to the public herein collectively referred to as product. The individual 1003 who is persuaded by the said stimulus to become a buyer, lessee, etc. of the promoted product, registers his or her intent to acquire the product identified in the advertisement 1001 in step 1004, which is an entering in the coupon dispenser or response unit 1005 of a request for a record 1008 described in FIG. 33.

[Column 100, lines 40-48].

In many instances, local or regional suppliers of goods and services develop their own and highly focused marketing priorities. As an example, a local retailer may wish to dispose rapidly of certain excess inventory or of perishable goods.

Nationally broadcast programs may not be the most suitable forum for such promotions.

[Column 76, line 67 – Column 77, line5].

Bergh thus describes that the number of items available for purchase is increasing exponentially and that the Bergh system may provide recommendations for items of any type that a user may sample in a domain. Von Kohorn describes that an individual who is persuaded by the content of an advertisement may indicate the persuasion by entering the intent to purchase the item into the Von Kohorn response unit. Further, Von Kohorn describes that national broadcast programs may not be the most suitable forum for promotions of local and regional suppliers of goods and services.

The following example illustrates an advantage of the instant claims. Nothing in any of the references of record suggest an embodiment of the present invention where a customer indicates a willingness to purchase Crest™ brand toothpaste from any one of Duane Reade™, Sav-On Drugs™ or Gristedes™ supermarket and allows a computing device to select the retailer from which the customer will purchase the Crest™ brand toothpaste.

We respectfully submit that the Bergh and Kanter references, alone or in combination, do not disclose all of the limitations of claims **43, 54, 59, 60, and 85-96**.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of claims **43, 54, 59, 60, and 85-96**.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent claims **43, 54, 59, 60, and 85-96** is incorrect, we request clarification of the Examiner's assertions above, so that the present application may proceed to allowance or appeal.

2. No Motivation to Combine the Cited References

The Examiner has not provided a motivation to combine the references of record to teach or suggest the limitations of Claims **43, 54, 59, 60, and 85-96**.

As best understood by us, the Examiner has attempted to create a chain of logic to assert that the references of record teach or suggest the limitations of Claims **43, 54, 59, 60, and 85-96**:

- Bergh discloses *a retail category where the retailer category is restaurants, clothing stores, World Wide Web pages, etc.* [Current Office Action, page 4]
- Von Kohorn discloses *the product can be a service or organization*
- *an organization can be a retailer* [Current Office Action, page 5]

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of the motivation above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

a. The Asserted Motivation is Not Shown in the Cited References

We have carefully reviewed the Office Action issued in the present application, as well as the Bergh and Von Kohorn references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references.

The Examiner does not assert otherwise.

b. The Cited References Are Not Analogous Art

If Applicants have misunderstood the Examiner's rejection, we respectfully submit that the Bergh and Von Kohorn references are not analogous art. It is a described object of the Bergh system to collect subjective ratings given to items by users, use the rating information to recommend items to users and allow users having similar tastes to communicate with each other. [Column 2, lines 9 - 20.] Bergh is accordingly directed to a method for facilitating exchange of user information, opinion and making recommendations based on such.

In contrast, Von Kohorn teaches away from these objects of Bergh.

Von Kohorn is directed to a method to "utilize shoppers' implementations of individual personal buying decisions, as evidenced by requested discount coupons, in the quantitative measurement of a shopper's buying behavior. At the same time, shoppers' buying decisions are used as yardsticks in the evaluation of the effectiveness of discrete functions of purchase stimuli." [Column 2, lines 13-20]. Von Kohorn is accordingly directed to a system for measuring the effectiveness of advertising by correlating requests for discount coupons in response to advertisements.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of claims **43, 54, 59, 60, and 85-96**. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims **43, 54, 59, 60, and 85-96**.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the list of the items above so that the present application may proceed to allowance or appeal.

For at least the reasons stated herein, we respectfully request allowance of the pending claims **43, 54, 59, 60, and 85-96**.

D. Dependent Claims 16, 22, 23 and 48

Claims **16, 22, 23 and 48** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,112,186 issued to Bergh et al. ("Bergh"), in view of U.S. Patent No. 5,970,469 issued to Scroggie et al. ("Scroggie"), in view of U.S. Patent No. 5,227,874 issued to Von Kohorn ("Von Kohorn"), and further in view of U.S. Patent No. 5,537,314 issued to Kanter ("Kanter"). We respectfully traverse the Examiner's Section 103(a) rejection.

We respectfully submit that claims **16, 22, 23 and 48** are not obvious in light of Bergh, Scroggie, Von Kohorn or Kanter, either alone or in combination. First, no combination of Bergh, Scroggie, Von Kohorn or Kanter teaches or suggests all of the features of claims **16, 22, 23 and 48**.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of claims 16, 22, 23 and 48.

**1. The References Do Not Disclose All the Limitations of Claims
16, 22, 23 and 48**

Dependent claims **16, 22, 23 and 48** generally recite the limitation *imposing a penalty if at least one selected item is not purchased*. Applicants are confused by the Examiner's application of the cited references to the limitation of the above claim. As best understood by us, the Examiner asserts the following to be true with respect to claims **16, 22, 23 and 48**:

Bergh discloses:

- *a penalty*
- *making a purchase* [Current Office Action, page 9]

Kanter discloses:

- *a penalty for failing to purchase an item selected* [Current Office Action, page 9]

We respectfully traverse these assertions. We have carefully reviewed the Bergh and Kanter references cited by the Examiner, without finding a teaching or suggestion of *imposing a penalty if at least one selected item is not purchased*.

Claims 16, 22, 23 and 48 generally recite *imposing a penalty if at least one selected item is not purchased*. Various embodiments of the present invention are directed to:

Levying or imposing a penalty against a customer or another person or entity may be necessary to avoid a number of different methods of cheating the method 100. For example, a customer may not be brand-indifferent within a product category (*i.e.*, the customer is brand-loyal and wants a particular brand). The customer may keep submitting or indications for product or service categories, all of which will be received during one or more implementations of the step 102, until the controller 202 selects the product or service during the step 104 that the customer wants. The customer then disregards any agreements that the customer has made for products or services that the customer does not want. Cheating by a customer or unfair advantage being taken by a customer may be prevented by imposing a penalty on the customer who does not purchase a product or service that the customer agreed to purchase.

[Specification, page 41, lines 16-27]. Applicants assert that no portion of the references of record even hint at the limitation as provided in the above example.

Contrary to the Examiner's assertion, Kanter is devoid of any hint or suggestion of *a penalty for failing to purchase an item selected*, let alone, *imposing a penalty if at least one selected item is not purchased*, as generally recited in claims 16, 22, 23 and 48.

Kanter describes:

Depositing the check often requires the participant to take the time to fill out a deposit slip. It also subjects the participant to the possibility of the check not clearing and the participant being charged a fee.

[Column 10, lines 30-34] Kanter thus describes a system in which a participant may be charged a fee for depositing a check that fails to clear. There is nothing in Kanter, however, that would suggest either *imposing a penalty for failing to purchase an item selected* or the claim language *imposing a penalty if at least one selected item is not purchased*.

We have carefully reviewed both the Bergh and Kanter references cited by the Examiner, without finding a teaching or suggestion of the above feature. Specifically, neither Bergh nor Kanter teaches or suggests *imposing a penalty if at least one selected item is not purchased* as generally recited in claims **16, 22, 23 and 48**.

We respectfully submit that the Bergh and Kanter references, alone or in combination, do not disclose all of the limitations of claims **16, 22, 23 and 48**. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of claims **16, 22, 23 and 48**.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent claims **16, 22, 23 and 48** is incorrect, we request clarification of the Examiner's assertions above, so that the present application may proceed to allowance or appeal.

2. No Motivation to Combine the Cited References

As best understood by us, the Examiner also asserts the following to be true with respect to independent Claim **16, 22, 23 and 48**:

- It would have been obvious to one of ordinary skill in the art to modify Bergh in light of Kanter to provide for *a penalty for failed purchases to Bergh's recommendation and purchase method*.
- The motivations for this modification in above would be so the Bergh can discourage purchases that are not possible. [Current Office Action, page 9].

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of the motivation above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

a. The Asserted Motivation is Not Shown in the Cited References

We have carefully reviewed the Office Action issued in the present application, as well as the Bergh and Kanter references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise. The Examiner's statement thus amounts to no more than a conclusory statement of a generalized advantage seen by the Examiner ("discouraging purchases that are not possible") and an unsupported allegation about what was known to those of ordinary skill.

**b. Asserted Motivation Does Not Suggest the Desirability of
*imposing a penalty if at least one selected item is not purchased***

Further, the motivation above, as asserted by the Examiner, would not suggest the desirability of modifying the recommendation system of Bergh to provide specifically for the feature of *imposing a penalty if at least one selected item is not purchased*, as generally recited in claims 16, 22, 23 and 48. The Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of discouraging purchases that are not possible, would specifically suggest to one of ordinary skill in the art the desirability of provide for *imposing a penalty if at least one*

selected item is not purchased in the Bergh system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivation in the Kanter reference amounts to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the Examiner. We respectfully submit that the purported motivations do not suggest any such modification of the Bergh system.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of claims **16, 22, 23 and 48**. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims **16, 22, 23 and 48**.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the list of the items above so that the present application may proceed to allowance or appeal.

For at least the reasons stated herein, we respectfully request allowance of the pending claims **16, 22, 23 and 48**.

E. New Independent Claims 101-103

Newly added Independent Claims 101-113 contain limitations generally directed to:

- receiving, from a customer, an indication of a willingness to purchase one of a plurality of products,
 - the indication including a binding agreement to purchase one product selected by a controlled from the plurality of products
- imposing a penalty if it has been determined the product is not purchased
- determining that a customer is not willing to purchase both the first product and the second product

- determining that the customer is willing to allow a computing device to select only one of the first product and the second product for the customer to purchase

Such features are not suggested by any of the cited references of record, alone or in combination.

Conclusion

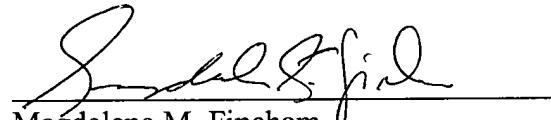
For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at jskinder@walkerdigital.com.

Respectfully submitted,

February 17, 2005
Date



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